

REMARKS

In this Amendment Under Rule 312, Applicants and their attorney are respectfully requesting that the Primary Examiner (and/or his SPE) correct an inadvertent error in allowed claim 150 in the application.

Claim 150 has been amended to correct the inadvertent deletion of a term from the base moieties, B' and B", that was effected in the previous amendments to the claim. In claim 150 above, the term "purine" is now properly included in the description for these two base moieties (see the recitation in the six (6) lines immediately following the structural formula set forth in step (a) above). In addition, language has been added to claim 150 in which the base moiety B is defined as representing "7-deazapurine, or pyrimidine moiety covalently bonded to the C1'-position of the sugar moiety, provided that whenever B is 7-deazapurine, the sugar moiety is attached at the N⁹-position of the 7-deazapurine, and whenever B is pyrimidine the sugar moiety is attached at the N¹-position of the pyrimidine." The insertion of the "purine" term for the B' and B" base moieties corresponds to the claim language that was originally presented in Applicants' January 25, 1993 Amendment Pursuant to 37 C.F.R. §1.115 (see pages 4 and 5 of that paper), and which language is fully supported by the original disclosure (see the instant specification, page 7, lines 28-33; page 25, lines 20-25; and originally filed claim 47).

Subsequent to that January 25, 1993 filing and the day after the issuance of a final Office Action on May 18, 1993, Dr. Dean L. Engelhardt, a representative of Enzo Diagnostics, Inc., the exclusive licensee, and the undersigned met with Dr. Marschel during which interview it was agreed that the C-8 purine modification would be deleted from the claims (without prejudice or disclaimer) to overcome the rejection under 35 U.S.C. §112, first paragraph (see May 19, 1993 Examiner Interview Summary Record).

In presenting the agreed changes to claim 150 in Applicants' Amendment Under 37 C.F.R. §1.115 filed the same day, the "purine" term was inadvertently deleted altogether from all three base moieties, B, B' and B" in the description of the instantly recited compound, and not just the agreed upon base moiety B. The term was deleted in at least two sets

of occurrences: one set being the six (6) lines immediately following the structural formula, and the second set being in the recitation in lines 14-16 after the formula. The latter recitation is directed to the modification of the purines (now deleted for the base moiety B), deazapurines and pyrimidines in accordance with the instantly claimed invention. The inadvertent nature of this error is supported by the original disclosure as well as the recent prosecution history of the application during which the enablement issue at hand concerned only modified C-8 purines in the recited compound. It was never intended or agreed to omit all purines from the instantly recited compound, just purines modified in the C-8 position as set forth for the base moiety B. It is believed, therefore, that the amendments above to claim 150 fully embrace the substance of the changes that were discussed and agreed at the May 19, 1993 interview.

It is fully understood that the foregoing amendments are a matter of grace and not of right for the Applicants - and that the Primary Examiner (and/or his SPE) can refuse their entry if so deemed. Under the circumstances, however, it is believed that these amendments clearly enhance the clarity of the instant claims. Moreover, it is believed that these amendments will conform the allowed claims with both the recent prosecution history (including the May 19th interview) and the original disclosure.

No fee is believed due in connection with this Amendment. If any fee is due, however, The Patent and Trademark Office is hereby authorized to charge the amount of any such fee to Deposit Account No. 05-1135.

If any questions remain regarding this Amendment, the Examiner is invited to telephone the undersigned at (212) 856-0876.

Respectfully submitted,



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